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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,002	08/18/2003	Mark Anthony Strom	314.001US1	2969

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EXAMINER
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SHAH, MILAP

ART UNIT	PAPER NUMBER
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3714

MAIL DATE	DELIVERY MODE
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05/07/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/643,002	<b>Applicant(s)</b> STROM, MARK ANTHONY	
	<b>Examiner</b> Milap Shah	<b>Art Unit</b> 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

This action is in response to the amendment filed February 8, 2007. The Examiner acknowledges that claims 1, 11, 12, & 14 were amended, no claims were canceled, and no new claims were added. Therefore, claims 1-20 are currently pending. The Examiner also acknowledges that the Applicant presented no response to the drawing and specification objections. Thus, these objections are maintained (see below).

#### *Drawings*

The drawings are objected to because of the reasons cited on the "Notice of Draftsperson Patent Drawing Review" form (PTO-948) provided with the non-final Office Action mailed November 8, 2006. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

*Specification*

The abstract of the disclosure is objected to because it appears to be exceeding the maximum of 150 words in length. Abstracts should be between 50-150 words in length. Correction is required. See MPEP § 608.01(b).

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (U.S. Patent No. 6,068,552) in view of Inoue (U.S. Patent No. 5,395,111).

**Claims 1 & 14:** Walker et al. disclose the invention substantially as claimed including a method of playing a wagering game comprising:

- a) a player placing a wager in a wagering machine having a processor (abstract & figure 1[coin acceptor 124 & CPU 102]);
- b) the wagering machine randomly displaying at least a single pay line of symbols, the symbols having a predetermined indication of order (column 3, lines 34-39 & figure 8[pay schedule 229 indicates the payout based on order of symbols appearing]);
- c) the processor determining from displayed symbols on the pay line whether the symbols provide at least one of at least two available predetermined orders of symbols that are associated with an award (figure 11A[pay table 1100], note: the pay table shows specific

awards per arrangement or sequence of symbols displayed and it clearly shows at least two predetermined orders, it is understood that the processor determines if the symbols shown match one of these predetermined orders to provide an award); and

d) providing the player with an award when at least one of the at least two available predetermined orders are displayed on a pay line (figure 11A[pay table 1100], note: just like any slot machine, once a pay table is used to determine an award, the award is provided to the player in some manner).

Walker et al. lack explicitly disclosing “the processor independently selecting a generic characteristic for at least one symbol and independently selecting a separate subgeneric characteristic for the at least one symbol”, which appears to represent a selection algorithm used in presenting the preselected symbols (i.e. based on the random outcome of the gaming machine). However, Inoue in a gaming machine in a similar field of endeavor discloses a unique selection algorithm to select which symbols are displayed to the player (based on the random outcome selected by the processor), where the selection of a symbol, such as a playing card in a poker game, is selected via a processor independently selecting a stopping location for two different concentric reels (column 2, lines 48-57), which each present a portion or characteristic of the symbol to be displayed (figure 7). Thus, Inoue teaches independently selecting a generic characteristic (i.e. a suit) and a subgeneric characteristic (i.e. a rank) via the concentric reels (figure 7 & column 1, line 56 – column 2, line 10). Inoue provides motivation for such a selection algorithm to be desirable in a gaming machine by offering a novel game sense and eliminating the monotony of conventional slot machines (which also applies to video simulated slots). Additionally, Inoue discloses by stopping reels at different times, interest in the game is increased, thus, by the same token,

the concept of Inoue's selection algorithm applied to Walker et al., would create a video slots version of Inoue where the symbols displayed to the player were created using a two-step process where the processor independently selects a generic characteristic and a subgeneric characteristic for said symbol (column 2, lines 3-10). Therefore, it would have been obvious to one of ordinary skill at the time of the invention to modify Walker et al. with the selection algorithm as taught by Inoue to provide a novel game sense and eliminate the monotony of a conventional slot machine, thereby increasing interest in the game as discussed by Inoue (see also abstract, figure 7, column 5, lines 44-53). It is to be noted the only modification being made to Walker et al. is the selection algorithm or technique for selecting which symbols are displayed on the video slot machine. Regarding claim 14, the "gaming apparatus" includes a housing, a processor, a symbol display area, and a user interface capacity as clearly seen in figures 1-12.

**Claims 2-6 & 15:** Walker et al. disclose a video poker embodiment (column 11, lines 20-49), in which it is understood that playing cards must be the indicia for a video poker game. Traditionally playing cards include both a rank and a suit, wherein the suit is considered the modifier that distinguishes like symbols into subsets of suits (i.e. 52 card deck has 13 cards each of 4 different suits, these 4 are considered the subsets). Regarding the latter part of claim 15, the pay table of a video poker embodiment, although not shown in Walker et al's figures, is traditionally considered to include a pay out for a straight flush, in which all the playing cards in a straight flush are in a particular predetermined order and have the same symbol modifier or suit.

**Claims 7-13:** The combination of Walker et al. & Inoue discloses the invention substantially as claimed except for explicitly disclosing the following:

a) the at least two predetermined orders of symbols are orders other than Royal Flushes with card symbols in ascending or descending order;

b) each frame in the pay line having a number of frames has a number of symbols available, exclusive of blank spaces, that is equal to the number of frames in the pay line (claim 11), and the number of frames on the pay line is five, and the symbols available are selected from the group consisting of Aces, Kings, Queens, Jacks, & Tens.

Regardless of these deficiencies, they would have been an obvious matter of design choice to a game designer at the time of the invention. It is considered a mere design consideration as to which order of symbols or indicia are included in the pay table. Thus, excluding Royal Flushes as claims 7-10 discuss, would have been an obvious matter of design choice, as the desired gaming apparatus by one of ordinary skill (i.e. the game designer) would have been to exclude such combinations from the pay table. For the same reason, adjusting the reel strip to include only a certain number of different symbols as discussed in claim 11, further in claim 12, that is equal to the number of different symbol positions (or frames), is a matter of design choice. Neither one of these design choices appear to overcome any stated problem or are for any particular purpose other than aesthetics. See MPEP 2144.04 in which aesthetic design changes and *In re Seid*, 161 F.2d 229, 73 USPQ 431 are discussed. Through *In re Seid*, it has been found that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patently distinguish the claimed invention from the prior art. Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to modify the combination of Walker et al. & Inoue to obtain the invention as specified in claims 7-13. Thus, regarding claim 13, the game designer is capable of implementing the specific claimed predetermined orders if they are desirable.

**Claim 16:** As discussed above, the combination of Walker et al. & Inoue disclose independently providing a first and second component to a playing card in a poker embodiment, where the first component may be considered the suit (as shown in figure 7 of Inoue), which is not order dependent, and the second component may be considered the rank (as shown in figure 7 of Inoue) which is considered order dependent for such outcomes as "straights", which are considered traditional outcomes in a video poker embodiment.

**Claims 17-20:** In addition to the above discussion, aesthetic changes also provides for a generic description being the suit, and the species component being an A, K, Q, J, or T (i.e. the top 5 card ranks). See also explanation of claims 7-13, in which it was discussed that a game designer is capable of designing the game using only A, K, Q, J, & T and is capable of setting the predetermined orders to anything conceivable (i.e. 5 consecutive ranks of cards), if those particular symbols/indicia are desirable or if those particular predetermined orders are desirable for the gaming machine being designed, since both the symbol/indicia used and the predetermine order added to a pay table are obvious matters of design choice by the game designer.

### *Response to Arguments*

Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Great Britain Patent No. 2,169,736 published on July 16, 1986 discloses the opportunity



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of players in a video poker game to change a single characteristic of displayed cards upon additional wagers or the like. Such as a player opting to change the suit of a 9 of diamonds to a randomly selected suit, which may very well be the 9 of hearts to give the player a flush winning combination if 4 other hearts appeared in the pay line. Thus, the patent teaches independently selecting both characteristics a playing card.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Milap Shah whose telephone number is (571) 272-1723. The examiner can normally be reached on M-F: 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MB.S.

A handwritten signature in black ink, appearing to read "Scott E. Jones". The signature is fluid and cursive, with the first name "Scott" and last name "Jones" being clearly legible.

**SCOTT JONES  
PRIMARY EXAMINER**